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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,191	02/13/2006	Tadashi Tomikawa	127021	8140
25944	7590	12/23/2011		
OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850			EXAMINER DECKER, PHILLIP	
			ART UNIT 3749	PAPER NUMBER
			NOTIFICATION DATE 12/23/2011	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OfficeAction25944@oliff.com  
jarnstrong@oliff.com

**Advisory Action**  
**Before the Filing of an Appeal Brief**

**Application No.**

10/568,191

**Applicant(s)**

TOMIKAWA ET AL.

**Examiner**

Phillip E. Decker

**Art Unit**

3749

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 21 October 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(g).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.  
NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.

6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 2-4-29.

Claim(s) withdrawn from consideration: 1-23

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_

13. ☒ Other: See Continuation Sheet.

/STEVEN B. MCALLISTER/  
Supervisory Patent Examiner, Art Unit 3749

The rejection as to claims 18 - 23 has been rendered moot by their cancelation. Regarding claim 24, Applicants argue that Aisin (JP '532) incorporates a circuit board, but the circuit board has no heat radiating member (p. 5). However, claim 24 does not require that the circuit board has a heat radiating member, but instead requires that the circuit board is affixed to a heat radiating member. Aisin discloses a circuit board 11, Drawing 2, shown to be affixed to a lower part of the case 8, which is also a part of the heat radiating members, fins 13, para. [0026].

Applicants also argue that Aisin as modified by Onizuka does not render the claims obvious because Onizuka is not combinable with Aisin and Onizuka does not contain all of the elements already disclosed by Aisin (pp. 5 - 6). In response, the Office respectfully points out that it is the combination of references that render the claims obvious, which cannot be overcome by arguing that one reference of the combination does not contain all the elements of the claims. Applicants also appear to argue that Onizuka is not analogous art (p. 5 line 20 - p. 6 line 3). However, both are concerned with power circuits in a vehicle engine room, the same as the Applicants, and therefore the references are analogous to the Applicants' field of endeavor. Claim 24 does not limit the application to anything more specific than that.

Finally, the Applicants argue that the Office's motivation to combine the references is merely conclusory and unreasonable, et al (pp. 6 - 8). In response, the Office maintains that the motivation to combine would have been obvious to one of ordinary skill in the art at the time of the invention because adding the case of Onizuka to the apparatus of Aisin to make it easier to manufacture and assemble. More particularly, Aisin's case 8 is drawn as a unitary structure in the drawings. It is difficult but possible to make a hollowed out area in the vicinity of 8c in Drawing 2. It might be possible to make the structure out of metal by molding, milling, or extruding, but the enclosed features and tight spaces make it very costly. Onizuka is concerned with reducing the costs and making it easier to manufacture (Abstract) and teaches making some parts out of metal and some out of resin. Onizuka teaches that the cover 60 is a separate part from the heat radiating member 56, and that it could be made of resin. It is also known that whether an element is integral (like the case of Aisin) or separable (like the cover of Onizuka) is not necessarily patentably distinguishable, and is not distinguishable in this case. If the cover is separable and made of resin, then it is "other than the heat radiating member." Furthermore, the cover would be easier to mold since it does not have to have enclosed spaces such as that shown in Aisin.

As to all other claims in this application, because Applicants have relied upon their assertions regarding claim 24 as the basis for patentability, there are no specific grounds regarding the rejections of these claims that need to be addressed.

Continuation of 13. Other: Regarding Box 7 above, amendment to claim 24 is entered because it fixes a minor objection by the Office. The objection to claim 24 is withdrawn.